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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,622	11/10/2003	Robert L. Browning	Browning 4.1-1	4684
21036	7590	10/24/2005		
MCLEOD & MOYNE, P.C. 2190 COMMONS PARKWAY OKEMOS, MI 48864			EXAMINER HAND, MELANIE JO	
			ART UNIT	PAPER NUMBER
			3761	
DATE MAILED: 10/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/705,622	BROWNING, ROBERT L.	
	Examiner	Art Unit	
	Melanie J. Hand	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/10/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: (1) a device for absorbing liquid comprising an insert with a thickness of 0.0625 inches and (2) a device for absorbing liquid comprising an insert with a thickness of 0.015625 inches

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if

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the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mary Moyne on October 19, 2005 a provisional election was made without traverse to prosecute the invention of species (1). Affirmation of this election must be made by applicant in replying to this Office action. Claim 13 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Priority

Acknowledgment is made of applicant's claim for priority under copending Provisional Application No. 60/425,450 filed on November 12, 2002.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on November 10, 2003 was filed on the mailing date of the Application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-11, 14-16, 20-22 and 24-26 rejected under 35 U.S.C. 102(b) as being anticipated by Grizzaffi (U.S. Patent No. 5,275,592).

With respect to **Claim 1**: Grizzaffi teaches an incontinence apparatus for males 10 comprising athletic supporter 20 further comprising an elastic waist band 22, pocket 21, and disposable insert 30 further comprising an inner liner 32, outer waterproof layer 31 and absorbent material 33 disposed therebetween. (Fig. 1) (Col. 3, lines 38-41, 45-48) Grizzaffi teaches penis-receiving cavity 37 located at the distal end of said insert 30 from said waist strap 22. (Fig. 3) (Col. 4, lines 2,3).

With respect to **Claim 2**: Grizzaffi teaches that insert 30 is capable of being attached only to a narrow waist band, thereby creating a configuration of apparatus 10 that is rotatable about the waist of the user. (Col. 4, lines 52,53)

With respect to **Claim 4**: Grizzaffi teaches that insert 30 is held against the user in pocket 21 of athletic supporter 20 which, as can best be seen from Fig. 1 is attached to the waist band 22 such that pocket 21 is behind the plane defined by the waist band and the outwardly-facing surface of pocket 21, therefore placing it between the waist band 22 and the waist of the user.

With respect to **Claim 6**: As can best be seen from Fig. 1, although pocket 21 is part of athletic supporter 20 that is attached to waist band 22, pocket 21 is spaced below said waist band.

With respect to **Claim 7**: Grizzaffi teaches that insert 30 is comprised of cotton (Col. 24-26) and that it further comprises a perforated film liner 32. (Col. 3 lines 45-47) Examiner is taking both teachings as encompassing a teaching of an insert 30 comprised of tissue.

With respect to **Claim 8**: Please see the rejection of Claim 1 above as the reason for which Claim 8 is rejected as anticipated by Grizzaffi has been addressed therein.

With respect to **Claim 9**: Grizzaffi teaches that absorbent layer 33 is comprised of a gel-creating substance 35, of which sodium polyacrylate is one example.

With respect to **Claims 10 and 11**: Grizzaffi teaches that outer layer 31 of insert 30 is comprised of a non-wicking waterproof material such as that used on the outside of disposable baby diapers. The materials that Grizzaffi teaches in this statement are well-known to be lightweight heatable tissue airlaid film materials. Thermostat fibers such as polyesters are examples of such materials.

With respect to **Claim 14**: The athletic supporter 20 taught by Grizzaffi along with waist band 22 are commercially available and widely known to be washable devices.

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With respect to **Claim 15**: As stated with respect to Claim 7, Grizzaffi teaches implicitly an insert (and thus a penis-receiving cavity 37) comprised of tissue, which is breathable.

With respect to **Claim 16**: Please see the rejection of Claims 10 and 11 above.

With respect to **Claims 17-19**: 103 ivo 714

With respect to **Claim 20**: Please see the rejection of Claim 1 as Claim 20 is rejected as anticipated by Grizzaffi for all of the reasons stated with respect to Claim 1 in addition to the following: Grizzaffi teaches penis-receiving cavity 37 such that at least an end of penis 41 is capable of being positioned by the user within insert 30. As stated with respect to Claim 1, insert 30 is disposable, therefore it is capable of being removed and replaced with a new insert 30 inside pocket 21.

With respect to **Claim 21**: Please see the rejection of Claim 2 above. Since the device 10 is rotatable about the waist of the user, the user is capable of misaligning pocket 21 with penis 41.

With respect to **Claim 22**: Grizzaffi teaches that apparatus 10 is acceptable for a normal daily routine, i.e. under clothing and therefore concealed, and said clothing can be removed for access to apparatus 10.

With respect to **Claim 24**: Please see the rejection of Claim 20 as Claim 24 is rejected for all of the same reasons as stated with respect to Claim 20 in addition to the following: Grizzaffi teaches that upon urine insult from penis 41, urine is absorbed and trapped by gel-creating substance 35 that then turns the absorbed urine into a semisolid gel, rendering it unable to leak

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further from the insert 30. Since the position of the insert 30 corresponds to a typical zipper position on pants or shorts, since leakage from insert 30 does not occur, leakage onto the clothing will not occur, and insert 30 is also easily accessible upon unzipping of the clothing and subsequent removal of penis 41 from insert 30, as occurs prior to urination.

With respect to **Claims 25 and 26**: Pocket 21 is considered herein to be capable of being flipped above the waist band 22 of the user prior to urination so as not to obstruct penis 41 and to facilitate removal of insert 30. (Col. 4, lines 19-23) As stated in Claim 2, apparatus 10 is also capable of being rotated in a direction parallel to the waist of a user, also allowing misalignment of pocket 21 to prevent obstruction of penis 41 during urination. The apparatus 10 is therefore also capable of realignment to its original position and the penis 41 repositioned in cavity 37.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grizzaffi ('592).

With respect to **Claim 3**: Grizzaffi does not explicitly teach the manner in which cavity 37 is formed, however since cavity 37 is structurally and functionally equivalent to the pouch of the claimed invention, an incontinence device of the claimed invention wherein said pouch is formed by folding is considered a product by process, and no merit is given to the process by which a product is formed, so long as the features of the prior art and the claimed invention are structurally and functionally identical.

Claims 5 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grizzaffi ('592) in view of Boyer et al (U.S. Patent No. 6,059,762).

With respect to **Claims 5 and 23**: Grizzaffi does not teach a notch in pocket 21. Boyer teaches an incontinence device with suspensatory 10 comprising a pouch 34 with absorbent panel 50 with opening 38 aligning with opening 28 of said suspensatory. (Fig. 3) Boyer teaches that said opening receives a user's penis and provides a more secure fit preventing leakage, therefore it would be obvious to modify the pocket and insert taught by Grizzaffi to have an opening in the same position with respect to said pocket as taught by Boyer.

Claims 12 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grizzaffi ('592) in view of Fuisz (U.S. Patent No. 4,700,714).

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With respect to **Claim 12**: Grizzaffi does not teach a particular thickness for insert 30. Fuisz teaches a urine collecting device 10 with a dry thickness of 1/16, or 0.0625 inches. Fuisz teaches that this thickness permits sponge absorbent body 25 to expand until filling the compartment 18 it is held in within device 10 (Col. 3, lines 16-27), thus controlling the amount body 25 is able to absorb and thus yielding a consistent device product, therefore it would be obvious to modify the thickness of insert 30 to be of a sufficiently small thickness such as that taught by Fuisz.

With respect to **Claims 17-19**: Grizzaffi does not teach an absorbent capacity for absorbent layer 33. Fuisz teaches that absorbent body 25 absorbs approximately 7 cc(=mL) of urine, or 0.238 fluid ounces. Since Fuisz also teaches a urine collecting device, it would be obvious to modify the amount able to be absorbed by layer 33 as taught by Grizzaffi to have an absorption capacity as taught by Fuisz.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie J Hand
Examiner
Art Unit 3761

MJH

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